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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,043	01/28/2004	Tomoko Maruyama	204552031700	9599
7590 Barry E. Bretschneider Morrison & Foerster LLP Suite 300 1650 Tysons Boulevard McLean, VA 22102				
02/01/2011				
EXAMINER				
CHEEMA, UMAR				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/765,043

**Applicant(s)**

MARUYAMA ET AL.

**Examiner**

UMAR CHEEMA

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

#### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/08/2010 has been entered.

#### **Response to Amendment**

2. This action is in response to the Request for Continued Examination (RCE) transmitted on 12/08/2010. Claims 1-15 are pending with claims 1, 11, and 12 as being independent claims. Claims 1, 11 and 12 have been further amended.

#### **Response to Arguments**

3. Applicant's arguments with respect to claims 1-15 have been considered but are in moot of the new ground(s) of rejection.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Noda (US Pub. No. 2003/0128387).

5. As to claims 1, 11 and 12, Noda discloses an image data transmitting method of a network scanner device (10) (Fig. 1) which attaches image data to electronic mail and transmits image data through a network (see at least abstract, ¶ (0007), communication device such as a network scanner and a network facsimile, for transmitting image data through e-mail) comprising steps of: a reading section for scanning a document to obtain image data (see at least ¶ (0041), Fig. 2, touch screen panel (20) to obtain data from the data memory (23)), a first setting section for setting up a recipient address to which the image data is to be transmitted (see at least abstract, ¶ (0013), Fig. 2, memory (23) stores the ID data of the addresses and addressors and a data selection control output from the memory data of addressees and addressors as candidates of addressees when a user set a addressee to whom the image data is to be sent), a storage section in which sender e-mail addresses associated with mail titles are stored, said sender e-mail addresses being distinct from a sending station address specifying the network scanner device (see at least ¶¶ (0005, 0006, 0013), storing users register ID data which may be such as names, IP addresses, electronic mail address, and the like of addressees and addressors which are often used by the network users); a second setting section for, when a sender e-mail address and mail title are selected from the sender e-mail addresses associated with mail titles stored in the storage section, setting up the selected sender

e-mail address and mail title in place of the sending station address (see at least abstract, ¶¶ (0019, 0042-0045, Figures 3,4; selecting user from the list of users in touch screen panel (shown in Fig. 3, 001 user nameA etc.) and by selecting the selected user, inputting user's e-mail address, IP address (name to be registered), password and storage holder name and registering the user (Fig. 4))), and a transmission control section for carrying out control for adding to the image data the sender e-mail address and the mail title set by the second setting section and transmitting the image data to the recipient address set by the first setting section (see at least ¶¶ (0047-0053), Figures 3, 4, 5; wherein e-mail transmission (52), PC transmission (53) (shown in Fig. 5) transmit scanning functions from the list of users from Fig. 3 etc.).

6. As to claim 2, Noda discloses a network scanner device as claimed in claim 1, further comprising a one-touch setting section (20)(Fig. 2) for setting up the recipient address and the sender e-mail address simultaneously (addressor registration control (21) and addressee registration control (22)) (Fig. 2).

7. As to claim 3, Noda discloses a network scanner device as claimed in claim 2, wherein the one-touch setting section carries out setting of the recipient address and the sender e-mail address, in accordance with instructions by the sender (see at least Fig. 2, addressor selection control and addressee selection control (24,25)).

8. As to claim 4, Noda discloses a network scanner device as claimed in claim 2, further comprising a display section that is capable of displaying information including the recipient

address and the sender e-mail address (see at least **Fig. 8 (Addressees List) and Fig. 10, list of Addressor user (100)**).

9. **As to claim 5**, Noda discloses a network scanner device as claimed in claim 1, further comprising a storage section in which candidates of recipient addresses associated with each sender e-mail address are stored, wherein, on setting of the sender e-mail address, the recipient address is chosen from candidates of recipient addresses associated with the sender e-mail address (see at least **Fig. 6, e-mail transmission Address Book**).

10. **As to claim 6**, Noda discloses a network scanner device as claimed in claim 1, further comprising a storage section in which sender e-mail addresses associated with IDs representing users are stored, wherein the sender e-mail address is automatically set up in accordance with an inputted ID (see at least **Fig. 13, selecting user of addressee automatically selects the e-mail address registered with the user**).

11. **As to claim 7**, Noda discloses a network scanner device as claimed in claim 6, further comprising an ID input prompting section for making a display that prompts input of an ID representing a user, as a condition for start of operations of the device (see at least ¶¶ (0046, 0047), Fig. 5).

12. **As to claim 8**, Noda discloses a network scanner device as claimed in claim 1, further comprising an operation panel by which information including the recipient address and the

sender e-mail address is inputted or chosen (see at least Fig. 12, input e-mail address of addressee/receiver and Fig. 13, select addressee from the list).

13. **As to claim 9**, Noda discloses a network scanner device as claimed in claim 1, wherein information including the recipient address and the sender e-mail address can be inputted through the network (see at least **Figures 1,12**).

14. **As to claim 10**, Noda discloses a network scanner device as claimed in claim 1, wherein the sending station address specifying the device is included in contents of a text of mail to which the image data is added (see at least ¶¶ (0048, 0056)).

15. **As to claim 13**, Noda discloses an image data transmitting method as claimed in Claim 12, wherein the step of scanning a document and obtaining image data, the step of setting the recipient address to which the image data is to be transmitted, and the step of setting the sender e-mail address representing the sender in place of the sending station address specifying the device are carried out in an altered sequence (see at least ¶¶ (0047-0053), **Figures 3, 4**).

16. **As to claim 14**, Noda discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by a user selection from addresses stored in the network scanner device in advance (see at least **Figures 3, 4**).

17. **As to claim 15**, Noda discloses a network scanner device as claimed in claim 1, wherein the designation of the sender e-mail address is carried out by an input of the sender e-mail address by a user (see at least ¶¶ (0047-0053)).

#### **Prior Arts of the Record**

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the form PTO-892 (Notice of Cited References) for a list of more relevant prior arts.

#### **Conclusion**

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/U. C./  
Examiner, Art Unit 2444

/Peling A Shaw/  
Primary Examiner, Art Unit 2444